

REMARKS

Claims 1-13 are pending in the application, and all 13 claims stand rejected. Claims 6, 7, 10, and 11 have been amended to correct a minor formal error in the preamble of each, relating to antecedent basis in their dependencies. Claims 1, 4, 8, and 13 have been amended for the reasons described below. No new matter is added by these amendments, and no estoppels are intended thereby. Applicants respectfully submit that the application is in condition for allowance.

Drawings

The Examiner has objected to Figures 3-5B, under 37 C.F.R. § 1.121(d) as “roughly drawn and improperly shaded.” At the Examiner’s suggestion, Applicants have “employ[ed] the services of a competent patent draftsman,” and Applicants have attached new Figures 1-5B, which Applicants believe to comply with Rule 121(d).

Claim Rejections – 35 USC § 112

The Examiner has rejected claims 1-11 and 13 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants respectfully traverse the rejection. The Examiner points to two places in claim 1 (and, by analogy, claims 4, 8, and 13) where antecedent basis is purportedly missing. Applicants have amended claims 1, 4, 8, and 13 to correct the antecedent basis issues for the phrase “the weighted table.” The Examiner also stated that “the qualifying products” in claim 1, subsection “j”, lacked antecedent basis. Antecedent basis for “the qualifying products” appears in subsection “g” of claim 1. Similar antecedent basis appears in claims 4, 8, and 13. For the foregoing reasons, Applicants respectfully request that the Examiner’s rejection under 35 U.S.C. § 112 be withdrawn.

Claim Rejections – 35 USC § 101

The examiner has rejected claims 1-13 under 35 U.S.C. § 101, as nonstatutory subject matter. Applicants respectfully traverse the rejection. The Examiner cites the purported “technological arts” test as the basis of his rejection. In the recent case *Ex Parte Lundgren*, Appeal No. 2003-2088, Application 08/093,516 (Precedential Board of Patent Appeals and Interferences opinion September 2005), the Board of Patent Appeals and Interferences (“Board”) “rejected the examiner’s argument that [*In re*] *Musgrave* [431 F.2d 882 (CCPA 1970)] and [*In re*] *Toma* [575 F.2d 872 (CCPA 1978)] created a technological arts test.” Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility (hereinafter “Guidelines”) at 45. Thus, “[t]he Board held that ‘there is currently no judicially recognized separate “technological arts” test to determine patent eligible subject matter under § 101.’” *Id.* (quoting *Lundgren* at 9). “USPTO personnel should no longer rely on the technological arts test to determine whether a claimed invention is directed to statutory subject matter.” *Id.* Because the “technological arts” test is not recognized by the USPTO, Applicants respectfully request that the Examiner’s rejections under § 101 be withdrawn.

Claim Rejections – 35 USC § 102

Claims 1, 4, 8, 12 and 13 stand rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 5,765,138 (Aycock). Applicants respectfully traverse the rejection. With respect to claim 1, Aycock does not disclose, teach, or suggest a number of aspects of the claimed invention. For example, claim 1 recites “a method for the identification and evaluation of software products and software product vendors and for creating a request for proposal.” Aycock does not teach or suggest such a method. The system in Aycock is designed for evaluating responses to requests for proposal that have already been created and distributed, not for creating requests for proposal. See,

e.g., Figure 1, wherein the bulk of Aycock's method takes place after box 18, labeled "receive completed RFP/RFQ from Supplier."

Additionally, Aycock does not disclose "ranking each feature and function," or "ranking software products according to how closely they match the features and functions in the created specification." For the aspect of claim 1 related to "ranking each feature or function," the Examiner points to column 2, lines 42-46, which reads, "[t]here is also a need for a system that provides a more efficient generation of requests for proposals (RFP/RFQs), whereby a system designer may select different standards depending upon their relevance." This statement at the beginning professes a need for an invention as described in the sentence, but does not point to any actual method steps or processes for carrying out such a step. Additionally, the statement mentions nothing about ranking features or functions, instead merely "select[ing]" standards depending upon their relevance.

For the aspect of claim 1 related to "ranking software products according to how closely they match the features and functions in the created specification," the Examiner cites a single sentence at column 10, lines 25-28: "[f]or example, a system designer may design the RFP/RFQ by determining at least part of the project objective by accessing the requirements for specific products from the product database 66." This sentence does not mention, disclose, teach, or suggest any type of ranking products, and therefore does not disclose this aspect of claim 1.

Additionally, Aycock does not disclose "generating a short list of vendors and products using the weighted table of qualifying products and vendors." Column 7, lines 46-65, cited by the Examiner, do not mention a weighted table of products and vendors. Elsewhere, Aycock mentions the weighting of maturity requirements, but not of products.

For all of these reasons, Aycock does not anticipate claim 1. Applicants respectfully

request that the rejection of claim 1 be withdrawn, and that claim 1 be allowed.

Claim 4 recites a system “to identify and evaluate software products and software product vendors and to create a proposal to send to the vendors.” As described above, the system in Aycock is designed for evaluating responses to requests for proposal that have already been created and distributed, not for creating requests for proposal. See, *e.g.*, Figure 1, wherein the bulk of Aycock’s method takes place after box 18, labeled “receive completed RFP/RFQ from Supplier.” Further, claim 4 recites program instructions to: “rank each feature and function,” “rank software products according to how closely they match the features and functions in the created specification,” and “generate a short list of vendors and products using the weighted table of qualifying products and vendors.” As described above with respect to claim 1, Aycock does not disclose these features. Therefore, Aycock cannot anticipate claim 4, and Applicants respectfully request that the rejection of claim 4 be withdrawn, and that claim 4 be allowed.

Claim 8 recites a system “to identify and evaluate software products and software product vendors and to create a proposal to send to the vendors.” As described above, the system in Aycock is designed for evaluating responses to requests for proposal that have already been created and distributed, not for creating requests for proposal. See, *e.g.*, Figure 1, wherein the bulk of Aycock’s method takes place after box 18, labeled “receive completed RFP/RFQ from Supplier.” Further, claim 8 recites devices to: “rank each feature and function,” “rank software products according to how closely they match the features and functions in the created specification,” and “generate a short list of vendors and products using the weighted table of qualifying products and vendors.” As described above with respect to claims 1 and 4, Aycock does not disclose these features. Therefore, Aycock cannot anticipate claim 8, and Applicants respectfully request that the rejection of claim 8 be withdrawn, and that claim 8 be allowed.

Claim 12 recites a system “to identify and evaluate software products and software product vendors and to create a proposal to send to the vendors.” As described above, the system in Aycock is designed for evaluating responses to requests for proposal that have already been created and distributed, not for creating requests for proposal. See, *e.g.*, Figure 1, wherein the bulk of Aycock’s method takes place after box 18, labeled “receive completed RFP/RFQ from Supplier.” Therefore, Aycock cannot anticipate claim 12, and Applicants respectfully request that the rejection of claim 12 be withdrawn, and that claim 12 be allowed.

Claim 13 is allowable because it is dependent upon claim 12, an allowable base claim. However, in addition, claim 13 further recites software to: “rank each feature and function,” “rank software products according to how closely they match the features and functions in the created specification,” and “generate a short list of vendors and products using the weighted table of qualifying products and vendors.” As described above with respect to claims 1, 4, and 8, Aycock does not disclose these features. Therefore, Aycock cannot anticipate claim 13, and Applicants respectfully request that the rejection of claim 13 be withdrawn, and that claim 13 be allowed.

Claim Rejections – 35 USC § 103

Claims 2, 3, 5-7, and 9-11 are rejected under 35 USC § 103 as being unpatentable over Aycock et al. Because claims 2, 3, 5-7, and 9-11 are dependent upon claims shown above to be allowable, claims 2, 3, 5-7, and 9-11 are also allowable, based at least upon their dependency upon an allowable base claim. Therefore, Applicants respectfully request that the rejection of claims 2, 3, 5-7, and 9-11 be withdrawn, and that claims 2, 3, 5-7, and 9-11 be allowed.

CONCLUSION

Favorable consideration of Applicant's application is therefore requested.

Respectfully submitted,

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